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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/716,471	11/20/2003	Akemi Sanada	NIT-308-03	6874
24956	7590	09/13/2007		
MATTINGLY, STANGER, MALUR & BRUNDIDGE, P.C. 1800 DIAGONAL ROAD SUITE 370 ALEXANDRIA, VA 22314			EXAMINER ADE, OGER GARCIA	
			ART UNIT 3627	PAPER NUMBER
			MAIL DATE 09/13/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/716,471	Applicant(s) SANADA ET AL.	
	Examiner Garcia Ade	Art Unit 3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 26 June 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 31-33,35-37 and 44-55 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 31-33,35-37 and 44-55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                 | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 26<sup>th</sup>, 2007 has been entered.

***Double Patenting***

2. Claims 31-33, 35-37, and 44-55 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 6,868,398. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are directed to the same invention.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 31-33, 35-37, 44-55 and rejected under 35 U.S.C. 103(a) as being unpatentable over Crawford [US 6,411,943], and further in view of Shear [US 4,827,508].

**As per claims 31, 32, 44, 50, and 51**, Crawford discloses a method for renting and charging for the use of the storage system comprising the steps of: providing the user with an initial volume of storage space of the storage system [see figure 1 (e.g. block 100 program storage, and figure 2 (e.g. block 210)], wherein the storage system held at the user's site has a management table (**Storage Charge Table 1010K**) which stores information regarding a state of use of disk drives [reads as **peripheral management programs**, via block 204]; charging the user for use of the initial volume at a predetermined rate [via Program & Information Rental Services (e.g. block 210), column 15, lines 39 – 44]; providing an additional added volume of storage space of the storage system as needed by the user [see flowchart of figure 8B (e.g. blocks 456 - 462 provide a generic description of **additional user request handling**)]; and charging the user

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for a portion of the additional volume that is actually used by the user at a first rate and charging the user for a remainder of the additional volume that is not actually used by the user at a second rate different from the first rate [see claim 43 (e.g. **a portion of a mass storage device associated with the customer's computing device to the service provider storage**), column 58, lines 44 – 54 (e.g. **storage usage charges assessed by the security programs into the Billing Data file** by matching Off-line Request begin and ending times)], wherein the owner of the storage system is notified when the user begins using a portion of the additional added volume [see section IX (e.g. Request Pending Table Occurs, Request, Date/Time, Estimated Completion, **Notify Method**)].

Crawford does not explicitly disclose: the storage system being held at a site of the user and not at a site of the owner, and the owner obtains information of the management table from the user's site. However, Shear discloses an absolute security and billing based on database usage system environment wherein all access tasks are performed at the user's site [see abstract and summary of the invention].

Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Crawford to include Shear's features mentioned above. Such a modification would have access system and method at a user site, a facility for measuring usage of the on-site usage for the purpose of billing the user according to the amount used, and for periodically conveying the measured usage information to the owner.

**As per claims 33, 36, 46, 48, 52, and 54**, Crawford discloses information about the state of use of the storage system by the user is recorded in a management table [**Storage Charge Table 1010K**], and wherein the state of use information stored in the management table is used in order to determine how much the user is to be charged for renting the storage system [see flowchart of figure 10 (e.g. block 504, **on-line service control data table**)].

**As per claims 35, 37, 47, 49, 53, and 55**, Crawford discloses the steps of: providing a display terminal to the user; and providing a display terminal to the owner; wherein both the user's display terminal and owner's display terminal are connected to the storage system via the internet so that both terminals can receive information regarding the state of use of the storage system by the user [see figure 3 (e.g. block 122, **local display devices may be connected to host computer 104 to allow local control over the host computer**)].

### **Response to Arguments**

6. Applicant's arguments with respect to claims 31-33, 35-37, and 44-55 have been considered but are moot in view of the new ground(s) of rejection.

### **Conclusion**


7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Garcia Ade whose telephone number is 571.272.5586. The examiner can normally be reached on M-F 8:30AM - 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Florian Zeender can be reached on 571.272.6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

8. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Garcia Ade  
Examiner  
Art Unit 3627

ga

  
Primary Examiner, AU 3627